

### Remarks

The Office Action mailed February 6, 2006 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Applicants and the undersigned wish to express their appreciation to Examiner Yu for the courtesies he extended during a recent telephone interview on this matter. During the interview, the Office Action dated February 6, 2006 and the cited references were discussed. The Examiner suggested that Applicants amend the independent claims to further include recitations directed to the structure of the stackable shipping trays. The foregoing Amendment has been made in consequence of the Examiner Interview. Accordingly, Applicants respectfully submit that the present patent application is in condition for allowance.

Claims 1-18 are pending in this application. Claims 1-18 stand rejected. Claim 16 has been cancelled. Claims 1, 4, 6, and 8 have been amended. No new matter has been added.

The rejection of Claims 1-12 and 14-16 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,390,847 (Young) in view of U.S. Patent No. 6,050,419 (Flanagan) and H1748 (Marinelli) and/or U.S. Patent No. 2,894,672 (Bamburg) is respectfully traversed.

Young describes a fruit and product container 10 having a bottom 12 and two side walls 14 formed of a common piece of corrugated cardboard. The container 10 also has two end walls 16 formed of laminated paperboard attached to the bottom 12 and side walls 14 to define a box. The container 10 can be stacked with other containers. The two laminated paperboard end walls 16 may enhance a stacking strength and moisture resistance of the container 10. A top 18 may be removably attached to stacking alignment tabs 22 that extend upwardly from the end walls 16.

Flanagan describes an adjustable-length, reusable, recyclable pallet wrap 10 for constraining a lading while displaying high-impact graphics. The pallet wrap 10 preferably has a set of horizontally-spaced, vertically oriented, preformed lines 32 of reduced resistance to bending at each of four regions to facilitate providing a snug fit around typical pallets 12 or loadings of various sizes. In one embodiment, a dual-function pallet wrap 10 is provided which

can function as a pallet skirt for in-store displays in addition to functioning as a constraint for the lading.

Marinelli describes a package for packs, for example packs of absorbent articles, each pack comprising a plurality of such absorbent articles and a wrapper of flexible material with a carrying handle at the top. The package comprises a plurality of packs disposed side by side and fixed together with adhesive tape. The adhesive tape being detachable without tearing the flexible material. Each handle is capable of supporting the weight of the entire package.

Bamburg describes stackable trays where a cover is applied to the uppermost tray. Opposing walls of the tray each have one stacking tab 29.

Claim 1 recites a shipping system for the facilitated packing and transportation of items, wherein the items are of a type requiring separation between vertically stacked layers, and the shipping system includes "at least one shipping unit, each shipping unit further comprising...at least two substantially open-topped shipping trays, wherein each of said shipping trays is operably configured to be capable of being stacked atop another of the at least two trays, wherein in the stacked configuration each of said shipping trays has at least one shipping tray positioned adjacent thereto such that a pair of adjacently stacked shipping trays includes an upper adjacent substantially open-topped shipping tray and a lower adjacent substantially open-topped shipping tray...each tray having a top, two opposing side walls and a bottom wall, the bottom wall having a bottom surface, each of the opposing side walls having at least two stacking tabs wherein the stacking tabs of one opposing side wall are substantially aligned with the stacking tabs of the other opposing side wall...a cover, operably configured to be positioned atop an uppermost one of said at least two substantially open-topped shipping trays of the at least one shipping unit, wherein the bottom wall of each upper adjacent substantially open-topped shipping tray is a lid for each lower adjacent substantially open-topped shipping tray...and at least one binding member, operably configured to hold the cover atop the uppermost substantially open-topped shipping tray of the at least one shipping unit, by extending at least partially across the cover and substantially between the stacking tabs of the uppermost substantially open-topped shipping tray, down the side walls and at least partially across the bottom wall of a plurality of stacked articles, wherein the binding member comprises at least one strip of adhesive material, simultaneously

engaging a top surface of the cover and the bottom surface of a bottom-most one of said at least two substantially open-topped shipping trays...wherein each substantially open-topped shipping tray of said at least two substantially open-topped shipping trays has substantially the same top plan configuration, and the cover has a top plan configuration substantially the same as each of said at least two substantially open-topped shipping trays.”

None of Young, Flanagan, Marinelli, or Bamburg considered alone or in combination, describes or suggests all of the recitations of Claim 1. For example, none of Young, Flanagan, Marinelli, or Bamburg, considered alone or in combination, describes or suggests a shipping system that includes a cover, at least one binding member, and trays with two opposing side walls wherein each side wall has at least two stacking tabs. The stacking tabs of one opposing side wall are substantially aligned with the stacking tabs of the other opposing side wall, and the binding member extends at least partially across the cover and substantially between the stacking tabs of the uppermost tray.

Neither Young nor Bamburg describe or suggest the shipping system recited in Claim 1. More specifically, Young and Bamburg do not describe or suggest a shipping system that includes a binding member that extends at least partially across a cover and substantially between stacking tabs of an uppermost tray, as required by the claimed invention. Rather, both Young and Bamburg simply describe stackable containers having a single alignment tab extending from the end walls.

Moreover, neither Flanagan nor Marinelli make up for the deficiencies of Young and Bamburg. Flanagan and Marinelli do not suggest or describe a shipping system that includes a binding member and trays with stacking tabs, as required by the claimed invention. Rather, Flanagan and Marinelli simply describe a pallet wrap and an adhesive tape, respectively, that are used to secure packages.

Because none of Young, Bamburg, Flanagan or Marinelli teaches or suggests one or more of the claimed limitations, it follows that a combination of Young, Bamburg, Flanagan and Marinelli cannot teach or suggest those limitations. Accordingly, Claim 1 is submitted to be patentable over Young in view of Flanagan and Marinelli and/or Bamburg.

Claims 2-12 and 14-15 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 1-12 and 14-15 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-12 and 14-15 likewise are patentable over Young in view of Flanagan and Marinelli and/or Bamburg.

Additionally, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Young with Flanagan, Marinelli, and/or Bamburg. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a

suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-12 and 14-16 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. §103(a) rejection of Claims 1-12 and 14-16 be withdrawn.

The rejection of Claims 1-12 and 14-18 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,860,590 (Blomfield) in view of U.S. Patent No. 6,050,419 (Flanagan); U.S. Patent No. 5,390,847 (Young); H1748 (Marinelli); and/or U.S. Patent No. 2,894,672 (Bamburg) is respectfully traversed.

Blomfield describes a stackable container formed from a blank, wherein the stackable container has four stacking tabs on each side wall.

Young, Bamburg, Flanagan and Marinelli are described above.

None of Blomfield, Young, Flanagan, Marinelli, or Bamburg considered alone or in combination, describes or suggests all of the recitations of Claim 1. For example, none of Blomfield, Young, Flanagan, Marinelli, or Bamburg, considered alone or in combination, describes or suggests a shipping system that includes a cover, at least one binding member, and trays with two opposing side walls wherein each side wall has at least two stacking tabs. The stacking tabs of one opposing side wall are substantially aligned with the stacking tabs of the other opposing side wall, and the binding member extends at least partially across the cover and substantially between the stacking tabs of the uppermost tray.

Like Young and Bamburg shown above, Blomfield does not describe or suggest the shipping system recited in Claim 1. More specifically, Blomfield does not describe or suggest a

shipping system that includes a binding member that extends at least partially across a cover and substantially between stacking tabs of an uppermost tray, as required by the claimed invention. Rather, the reference simply describes stackable containers having alignment tabs extending from the walls.

Moreover, neither Flanagan nor Marinelli make up for the deficiencies of Blomfield, Young, and Bamburg. Flanagan and Marinelli do not suggest or describe a shipping system that includes a binding member and trays with stacking tabs, as required by the claimed invention. Rather, Flanagan and Marinelli simply describe a pallet wrap and an adhesive tape, respectively, that are used to secure packages.

Because none of Blomfield, Young, Bamburg, Flanagan or Marinelli teaches or suggests one or more of the claimed limitations, it follows that a combination of Blomfield, Young, Bamburg, Flanagan or Marinelli cannot teach or suggest those limitations. Accordingly, Claim 1 is submitted to be patentable over Blomfield in view of Young, Bamburg, Flanagan or Marinelli.

Claims 2-12, 14-15, and 17-18 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-12, 14-15, and 17-18 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-12, 14-15, and 17-18 likewise are patentable over Blomfield in view of Flanagan, Young, Marinelli and/or Bamburg.

Additionally, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Blomfield, with Young, Flanagan, Marinelli, and/or Bamburg. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability

of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-12 and 14-18 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. §103(a) rejection of Claims 1-12, 14-18 be withdrawn.

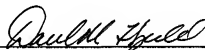
The rejection of Claim 13 under 35 U.S.C. § 103(a) as unpatentable over the references applied above with respect to Claim 1, and further in view of Presentation Brochure, "Corrugated Common Footprint for Product Packaging, Kroger, September 13, 2000", by Fibre Box Association (Corrugated Common Footprint) is respectfully traversed.

Claim 13 depends from independent Claim 1. When the recitations of Claim 13 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claim 13 likewise is patentable over the references and further in view of Corrugated Common Footprint.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. §103(a) rejection of Claim 13 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in the application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully submitted,



---

Daniel M. Fitzgerald  
Registration No. 38,880  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070